

REMARKS**I. Co-pending Applications**

In response to the Examiner's request, Applicant believes that the following related applications are pending before the USPTO:

1. Application Serial No. 11/785,757, with Art Unit 3774, Examiner Paul PREBILIC;
2. Application Serial No. 11/042,546, with Art Unit 3774, Examiner Paul PREBILIC;
3. Application Serial No. 10/182,352, with Art Unit 3733, Examiner Mary HOFFMAN; and,
4. Application Serial No. 09/890,172, with Art Unit 3774, Examiner Paul PREBILIC.

It is believed that all of the claims of the aforementioned applications are available in IFW format on PAIR

II. Claim Objections

The Examiner's objections to claims 5 and 6 based on clarity are noted. Claims 4-6 have been amended to more clearly associate the new claim limitations of these claims with already introduced structural limitations.

Namely, claim 4 has been amended to clarify that a first end of the deformer and a first end of the tube engage.

Claim 5 has been amended to clarify that a second end of the deformer cooperates with a first end of the deformer.

Claim 6 has been amended to clarify that the first and second ends of the deformer lock with the axial member.

III. Rejection of claims 1, 2, 4-8, 10-21, 23-26 and 30-42 under 35 USC §102(b)

The Examiner has indicated that claims 1, 2, 4-8, 10-21, 23-26 and 30-42 are not novel under 35 USC §102(b) in view of US 5,707,390 to *Bonutti* ("D1"). In view of the

amendments to claim 1, Applicant disagrees with the Examiner's indication for the reasons set forth below.

Applicant has amended claim 1 to include the limitation that the tube is slotted along a majority of its length in the axial direction. Support for this amendment can be found on page 14, lines 16 and 17 and in FIGS. 1A, 1G, 1H, 9B, and 9F, *inter alia*, of the parent application PCT/IL2004/000527.

It is noted that the sleeve (14) of D1 is only slotted at the most distal end in most of the embodiments described. In other embodiments, an additional tier of slots is described; however they are intended to be used in a very specific embodiment wherein surgical instruments are used in between the distal end slots and the additional tier of slots. In that very specific embodiment there can be no slots in between the distal end and the additional tier occupying a majority of the length of the sleeve in the axial direction since that is the operational area of D1 where surgical instruments are extended through a port in the side of the sleeve.

Therefore amended independent claim 1, and the claims that depend from it, are novel in view of D1.

IV. Rejection of claims 27-29 under 35 USC §103(a)

The Examiner has indicated that claims 27-29 are obvious under 35 USC §103(a) in view of D1. Applicant disagrees with the Examiner's indication for the reasons set forth below.

As discussed above, claim 1 has been amended to include the limitation that the slots extend along a majority of the length of the tube in the axial direction. D1 does not describe this limitation nor is there any reason given in the D1 specification for providing it.

In fact, D1 actually teaches away from providing slots extending along a majority of the length of the tube. D1 states that a problem needing to be solved with current bladder retraction devices is their relatively large surface area of contact. Col 1, line 45. Presumably, this is why D1 is designed to have a single set of arms for tissue manipulation, to minimize surface area contact between the device and the tissue.

Therefore, since a tube with slots provided along a majority of the length of the tube when expanded will create multiple points of contact all along the axis of the tube, this limitation is exactly what D1 is attempting to avoid and there is absolutely no reason to combine D1 with any reference to teach the invention of currently amended claim 1.

In addition, D1 indicates that another problem with devices with large areas of surface contact is that they do not expand only at or near the tip, see Col. 1, line 49, further indication that a device which expands along its length in an axial direction is undesirable in the view of D1.

For at least these two reasons, D1 teaches away from using multiple slots extending along a length of the device's shaft and therefore, claims 27-29 are not obvious in view of D1.

In view of the above amendments and remarks it is respectfully submitted that claims 1, 2, 4-8, 10-21, and 23-42 are now in condition for allowance. A prompt notice of allowance is respectfully and earnestly solicited.

Respectfully submitted,

A handwritten signature in cursive script, reading "Martin D. Moynihan".

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